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COMMISSIONER OF PATENTS

OF THE DEPARTMENT OF COMMERCE, UNITED STATES PATENT OFFICE

BRIEF FOR THE COMMISSIONER OF PATENTS

RECEIVED

The opinion of the District Court (R. 33-73) is reported at 336 F. Supp. 406. The opinion of the court of appeals (R. 33-87) is reported at 336 F. 2d 786.

JUDGMENT

The judgment of the court of appeals was entered on November 23, 1964 (R. 33). The petition for a writ of certiorari was filed on February 18, 1965 and granted on April 4, 1965 (R. 33). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether a "preemptive patent"—i.e., a patent applied for before the invention and application in issue but granted after the application in issue—is a relevant

In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 57

HAZELTINE RESEARCH, INC., ET AL., PETITIONERS

v.

COMMISSIONER OF PATENTS

**ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT**

BRIEF FOR THE COMMISSIONER OF PATENTS

OPINIONS BELOW

The opinion of the district court (R. 69-74) is reported at 226 F. Supp. 459. The opinion of the court of appeals (R. 82-83) is reported at 340 F. 2d 786.

JURISDICTION

The judgment of the court of appeals was entered on November 25, 1964 (R. 83). The petition for a writ of certiorari was filed on February 18, 1965 and granted on April 5, 1965 (R. 85). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether a "copending patent"—i.e., a patent applied for before the invention and application in issue but granted after the application in issue—is a relevant

reference in determining whether there has been a patentable advance in the art under Section 103 of the Patent Act.

STATUTES INVOLVED

Title 35 of the United States Code provides in pertinent part:

§ 101: Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102: Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

* * * * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent * * *.

§ 103: Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought

to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

STATEMENT

On December 23, 1957, petitioner Robert Regis filed an application for a patent on a microwave switch (R. 9-15).¹ The application was denied by the patent examiner on June 24, 1959, on the ground that the claims set forth therein were "unpatentable over" a patent (No. 2,822,526) issued to Wallace in 1958, "in view of" a 1949 patent issued to Carlson (No. 2,491,644) (R. 23). It is conceded that if Regis' application is judged against the Wallace and Carlson patents, it does not disclose a patentable advance within Section 103 of the Act (35 U.S.C. 103) (precluding patents on developments "obvious" in light of the "prior art" "to a person having ordinary skill in the art"); the question presented is whether the Wallace patent was, in fact, properly employed as a reference relevant to the patentability of Regis' claims.

The Carlson patent had been issued on December 20, 1949, well before Regis' application and invention, and was thus indisputably part of the art in light of which Regis' claim to a patent was to be judged. The Wallace patent, however, was a "copending pat-

¹Three days before Regis filed his application, he assigned his entire interest in the invention and the application to petitioner Hazeltine Research, Inc. (R. 47).

ent" with Regis; that is, although Wallace had applied for a patent prior to the Regis invention and application, Wallace's patent was not issued until after the Regis application was filed.² Petitioners argued before the Patent Office that such a "co-pending patent" was an improper reference to determine whether Regis' invention was a patentable advance in the art under Section 103. (R. 22, 26-32). The examiner rejected this contention (R. 23) and his decision was upheld by the Board of Appeals of the Patent Office (R. 42-45).

Petitioners then instituted the present action in the district court pursuant to Section 145 of the Act (35 U.S.C. 145), seeking to compel the Commissioner of Patents to issue a patent on the invention described in Regis' application (R. 1-4). The district court dismissed petitioners' complaint (R. 75). After noting petitioners' concession that, if the Wallace patent was a relevant reference, the combination of Wallace

² The Wallace application was filed on March 24, 1954. The Regis application was filed on December 23, 1957. A patent was issued on the Wallace application on February 4, 1958 (R. 34).

With regard to Regis' invention date, his complaint (R. 2) alleged merely that it had been "[p]rior to December 23, 1957" (the date of his application). However, the Examiner's Answer before the Patent Office Board of Appeals (R. 35) reveals that Regis "has not sworn back of either reference under the provision of Rule 131 [37 C.F.R. 1.131]," giving an applicant whose claim is rejected upon the basis of a reference to a domestic patent an opportunity to allege "a completion of the invention in this country before the filing date of the application on which the domestic patent issued. * * *" Hence it is assumed throughout (which petitioners do not dispute) that Regis' alleged invention, as well as Regis' application, was made after Wallace's application.

with Carlson would negate the patentability of Regis under Section 103 (R. 69), the court held that "copending patents" were "included in the 'prior art', as that term is used in 35 U.S.C. 103." The court based its decision upon two considerations: (1) prior to the enactment of the Patent Act of 1952, a copending patent would have clearly been a reference relevant to show that claims were unpatentable for failure to make a significant advance in the art; (2) the 1952 Act, as shown by its legislative history, did not change the law in this respect (R. 70-74). The court of appeals affirmed, *per curiam* (R. 82-83).

ARGUMENT

Introduction and Summary

The single question raised by petitioners in this case concerns the use which may be made, in judging the patentability of an alleged invention under Section 103 of the Patent Act (35 U.S.C. 103), of disclosures of prior inventions contained in "copending patents." A copending patent, for this purpose, is a patent on a prior invention which was already *applied for* at the time of the invention and application in issue, but which is not *issued* until after the filing date of the application in issue; a period of time exists, therefore, when the two applications are "copending" before the Patent Office and neither has been granted. The Wallace patent in this case was, for a short time, such a copending patent with respect to the Regis application which is the subject matter of the litigation. The Wallace application was filed in 1954—

before Regis' alleged invention.³ The Wallace patent did not issue, however, until February, 1958, a little more than one month after Regis' patent application was filed in December, 1957. The two patents were thus copending for the short period between Regis' filing date in December, 1957, and Wallace's patent date in February, 1958.

In these circumstances, the Patent Office, the district court and the court of appeals have held that the patentability of Regis' alleged invention must be judged in light of the disclosures of the copending Wallace patent just as if Wallace's patent had issued before, rather than a few weeks after, Regis' invention. It is conceded that, so judged, the Regis invention is not patentable, since the differences between it and the Wallace patent, viewed in light of a 1949 patent issued to Carlson, would have been obvious "to a person having ordinary skill in the art" within the doctrine of *Hotchkiss v. Greenwood*, 11 How. 248, codified in Section 103 of the 1952 Patent Act. Thus the sole question is whether Wallace was correctly used as a reference relevant in judging the patentability of Regis under Section 103. We submit that it was.

The Patent Office and the courts below invoked the principle—established by this Court's 1926 decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390—that, for the purpose of judging the

³ See footnote 2, *supra*, p. 4.

patentability of a subsequent invention, a copending and ultimately issued United States patent *dates from the time when the application was filed* rather than from the date when the patent is ultimately issued. The instant case comes within this rule because Wallace invented and filed before Regis did, although Wallace's application was not finally processed until after Regis had applied for a patent. The principle of the *Milburn* case, originally a judicial gloss upon the patent statute, has since been explicitly codified in Section 102(e) of the 1952 Patent Act (35 U.S.C. 102(e)), providing that a patent shall not issue if "the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent." The 1952 Act thus treats copending patents as equivalent to previously issued patents, which are relevant references under Section 102(a) (35 U.S.C. 102(a)).

Although petitioners appear to concede the general validity of the *Milburn* principle under the 1952 Patent Act, they seek to limit its applicability to a special class of cases. Specifically, petitioners urge that while the *Milburn* rule applies when a copending patent discloses the *exact* invention claimed in an application on a subsequent "invention," the rule does not apply when the subsequent application contains

some difference from, or variation upon, the copending patent. This is so, petitioners argue, even though the difference or variation, as in this case, is an insignificant one which would not constitute a patentable advance over the copending patent under Section 103.

Petitioners' argument rests principally upon the language used by Congress in 1952 in codifying the rule precluding patents upon variations obvious "to a person having ordinary skill in the art." Congress stated in Section 103 that the relevant references in judging such obviousness were those in the "prior art" at the date of the invention in issue. In petitioners' view, the words "prior art" must be taken to refer only to patents already *issued* as described in Section 102(a) of the Act, and cannot refer to copending patents as described in Section 102(e). Thus petitioners urge that copending patents are not "prior art"—and hence are not relevant—for purposes of judging patentability under Section 103.

We show below that the limitation which petitioners would thus place upon the use of copending patents is novel and wholly unwarranted. While there was—and there remains—some confusion in the use of the term "prior art" in judicial opinions in the lower courts, it was, as we show, entirely clear before the 1952 Act that disclosures of prior inventions in copending patents (whether or not such patents were technically labelled "prior art") were competent,

under the rule of this Court's *Milburn* decision, to negate patentability for lack of a significant advance in the art under *Hotchkiss v. Greenwood*. When the *Milburn* and *Hotchkiss* rules were codified in Sections 102(e) and 103 of the 1952 Act there was no suggestion in either the statute or the legislative history that a limiting change in this use of copending references was intended; nor has any case or commentary since the 1952 Act suggested such a purpose. Thus the result which obtained before 1952 continues to govern today, as several decisions of the lower courts have held. In short, copending patents remain relevant references in determining whether an application discloses a significant advance in the art. Indeed, any other rule would create a danger of numerous overlapping patents prejudicial to the public and to legitimate prior inventors.

Finally, Congress' use of the term "prior art" in Section 103 of the 1952 Act, upon which petitioners principally rely, is fully consistent with the use of copending patents in Section 103 cases. Whatever confusion once existed in the lower courts, this Court had made it clear in 1941 that copending patents "constituted prior art," *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, 265, and it is reasonable to suppose that Congress so understood the term when it incorporated it in Section 103. Hence "prior art" in Section 103 includes copending references as described in Section

102(e) as well as previously issued references as described in Section 102(a).

I

PRIOR TO THE 1952 PATENT ACT, COPENDING PATENTS WERE UNQUESTIONABLY RELEVANT REFERENCES IN DETERMINING WHETHER SUBSEQUENT INVENTIONS DISCLOSED A PATENTABLE ADVANCE IN THE ART

It has always been assumed, as petitioners acknowledge, that an invention is unpatentable if the identical invention, achieved at a prior time by another inventor, is claimed in a copending patent application. This result follows not from any special rule as to copending patents, but from the basic and guiding principle that priority is determinative. This rule of prior invention is now codified in Section 102(g) of the Patent Act (35 U.S.C. 102(g)), which provides that an applicant shall not be entitled to a patent if, "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." Section 135 of the Act (35 U.S.C. 135) provides for so-called interference proceedings to determine the factual issue of priority when a question is raised in that regard.

While the problem of copending *identical* patents has thus always been solved in principle by a straightforward application of the rule of priority of invention, the answer was not always so clear in cases where the copending applications did not claim a patent on exactly the same invention, but where the

disclosures in the prior copending patent nevertheless would, if considered to be part of the relevant art, affect the patentability of the subsequent patent by showing it to be an insignificant advance in the art. A rule for such cases—similar to the rule applied to identical claims—was, however, established by this Court in 1926 in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390. It is this rule, now codified in Section 102(e) of the Act, which disposes of the present case.

In the *Milburn* case, the copending patentees were Clifford and Whitford. (Both patents were issued by the Patent Office, the question of the validity of Whitford's patent being raised against his assignee in infringement proceedings). Clifford, the prior inventor and applicant, "gave a complete and adequate description of the thing patented to Whitford [the subsequent inventor and applicant], but * * * did not claim it." 270 U.S. at 399. Clifford's disclosures were not revealed prior to Whitford except in Clifford's patent application; hence they did not come within the rule now codified in Section 102(a) of the Act (35 U.S.C. 102(a)), that patentability must be judged in light of disclosures actually patented or published before the invention in question. In the district court, Judge Learned Hand held Whitford's patent valid despite the disclosures in Clifford's prior copending patent. In Judge Hand's view, copending applications were properly used only to show that a prior inventor was entitled to the patent claimed. Since Clifford did

not *claim* the disclosures later claimed by Whitford (although he described Whitford's claims) Clifford was not a prior inventor competing for the same patent and his copending disclosures, not otherwise part of the known art prior to Whitford's invention, could not bear upon the patentability of Whitford. See 297 Fed. 846, 851-854. The court of appeals affirmed. 1 F. 2d 227.

In a unanimous opinion written by Mr. Justice Holmes, this Court reversed. The Court held that copending patents were relevant not only to resolve competing claims between inventors claiming the same invention, but also to determine whether a subsequent inventor has made a patentable invention—regardless of the identity of his claims with those made by other inventors. The Court reached this result by considering as immaterial the delays occasioned in the Patent Office between the filing and issuing date of a patent application. It observed that if Clifford's patent had actually issued before Whitford applied, his disclosures would have been part of the relevant art by which Whitford's claims would be judged, even though Clifford did not claim Whitford's "invention." This being true, "a sound distinction cannot be taken between that case and a patent applied for before but not granted until after a second patent is sought. The delays of the patent office ought not to cut down the effect of what has been done. * * * Clifford had done all that he could do to make his description public. * * * We see no reason in the words or policy of the law for allowing

Whitford to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Clifford had shown knowledge inconsistent with the allowance of Whitford's claim * * *'' (270 U.S. at 400-401). Thus, the Court concluded, since the prior Clifford patent ultimately issued, the question whether to issue an additional subsequent patent to Whitford must be decided in light of Clifford.

As stated in the Reviser's Note accompanying the incorporation of the *Milburn* decision into the 1952 Act (as Section 102(e)), *Milburn* means that, "for the purpose of anticipating a subsequent inventor," "a United States patent disclosing an invention dates from the date of filing the application." Under this standard, the Regis invention in this case was unpatentable, since it disclosed no patentable advance over Wallace, which had been previously filed in the Patent Office.

Although there is a factual difference between the *Milburn* case and the present one, the cases are not distinguishable. The prior Clifford application (involved in *Milburn*) did not claim the subject matter of Whitford's patent, but did give "a complete and adequate description of the thing patented to Whitford" (270 U.S. at 399). In the instant case, Wallace and Carlson did not thus completely describe the Regis invention; they did, however, make claims, in light of which Regis' invention is unpatentable as an insignificant advance in the art. The theory of the *Milburn* case applies equally to both situations. Delays

within the Patent Office are to be ignored and the Wallace patent deemed prior to Regis' invention. Regis is, consequently, unpatentable whether identically disclosed by Wallace and Carlson or merely an insignificant advance over those two patents.

That the *Milburn* doctrine of copending patents thus applies to the present case was demonstrated beyond doubt by the Court's express holding, in 1941, in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, that "copending patents," regardless of whether they partially or completely disclose the claimed subject matter, constitute a part of the prior art by which patentability must be judged. The *Detrola* case involved the alleged infringement of a patent issued to Wheeler on a radio circuit. In an infringement proceeding instituted by Hazeltine, Wheeler's assignee, this Court stated (313 U.S. at 264-265; emphasis added):

The defendant insisted that the [Wheeler] patent involved no invention in view of the prior art and cited patents issued before Wheeler's date of conception and others issued before the patent in suit on applications antedating his date of invention and pending when his application was filed [i.e., copending patents].

Some of these were for transmission systems and some for receiving systems. Several disclosed automatic amplification control. All constituted prior art. [Footnote citing *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390.]

Indisputably, the copending patents referred to in *Detrola* were of the type involved in the instant case, i.e., patents not identical with the subsequent invention, but in light of which that invention would have been obvious to one skilled in the art within the doctrine of *Hotchkiss v. Greenwood*, *supra*, and Section 103 of the Act. For, after analyzing in detail the relationship between Wheeler's patent and the prior art cited against Wheeler, including copending patents, the Court concluded, with special emphasis upon the copending elements in the prior art, that (313 U.S. at 269; emphasis added):

Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, *notwithstanding the fact he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor, since his advance over the prior art, if any, required only the exercise of the skill of the art.*⁴

⁴Petitioners contend that the question whether copending patents which partially disclose the claimed subject matter constitute prior art was neither presented to, nor decided by the Court, in *Detrola* (Pet. Br., pp. 17-18). While the briefs filed with the Court did not specifically raise the question, it is nevertheless clear that the issue was raised by the facts of the case and that the Court explicitly passed on this issue in considering copending patents revealing only partial elements of Wheeler's "invention." Moreover, shortly after *Detrola*, in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 89, the Court again made explicit use of a copending patent which, it said, "differed from Mead [the application in question] in several respects."

The same result was also reached in lower court decisions prior to 1952. In the footnote, we list fourteen cases which we have found in the courts of appeals and the United States Court of Customs and Patent Appeals, decided after the *Milburn* case, which clearly used one or more copending patents to determine patentability in situations where the individual copending patents were recognized as not completely disclosing the subsequent invention, but as only partially disclosing it so as to negate patentability under the rule of *Hotchkiss v. Greenwood*.⁵

The language of many of these cases reads directly upon the present case. Indeed, in *Western States Mach. Co. v. S. S. Hepworth Co.*, *supra*, at 348-349 Judge Learned Hand addressed himself directly to—

⁵ *Sherwin Williams Co. v. Marzall*, 190 F. 2d 606 (C.A.D.C.); *United Specialties Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C.A. 6); *Permo, Inc. v. Hudson-Ross, Inc.*, 179 F. 2d 386 (C.A. 7); *Conmar Products Corporation v. Universal Slide Fastener Co.*, 172 F. 2d 150 (C.A. 2); *Application of Seid*, 161 F. 2d 229 (C.C.P.A.); *Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F. 2d 345, 348-349 (C.A. 2), certiorari denied, 325 U.S. 873; *Dyer v. Coe*, 125 F. 2d 192 (C.A.D.C.); *L. Sonneborn Sons, Inc. v. Coe*, 104 F. 2d 230 (C.A.D.C.); *Minnesota Mining & Mfg. Co. v. Coe*, 100 F. 2d 429, 430-431 (C.A.D.C.); *In re Walker*, 99 F. 2d 976 (C.C.P.A.); *In re Youker*, 77 F. 2d 624 (C.C.P.A.); *In re Williams*, 62 F. 2d 86 (C.C.P.A.); *Ottinger v. Ferro Stamping & Mfg. Co.*, 59 F. 2d 640 (C.A. 6); *Denaro v. Maryland Baking Co.*, 50 F. 2d 1074 (C.A. 4) (adopting the opinion of the district court reported at 40 F. 2d 513 (D. Md.)). See also *Old Town Ribbon & Carbon Co. v. Columbia Ribbon & Carbon Mfg. Co.*, 159 F. 2d 379 (C.A. 2) where it is not clear from the opinion whether or not the disclosures in the copending patent were identical or partially anticipatory, but where the opinion clearly shows that that factor is irrelevant.

and explicitly rejected—the distinction which petitioners now seek to create—that copending patents may only be used to show an identical prior invention, but not to show a non-patentable advance in the art. At the outset, Judge Hand notes that the *Milburn* decision (reversing his decision as district judge) now “makes it proper to speak of a prior application as ‘prior art’ ” (147 F. 2d at 348). Judge Hand then recognizes the contention—made here by petitioners—that “no application will serve to invalidate the later invention except one that contains in its disclosure all that is in the later application”; that a copending application, in other words, “could not be used merely as an encroachment upon the field which the later invention occupied, even although it left unoccupied too little to support a patent” (*ibid.*). Judge Hand goes on (at 348-349):

It is of course possible to reason in this way, but it appears to us to involve the same pre-supposition which the Supreme Court overruled in *Alexander Milburn Co. v. Davis-Bournonville Co.*, *supra* * * *. That decision—as we understand it—meant to disregard the fact that an earlier application did not at the moment enrich the art; it proceeded upon the assumption—perhaps not fully expressed, but implied—that since its disclosure would eventually fall into the public demesne quite as much as though it were presently published, the interval during which it remained secret should be disregarded. True, that was not necessary for the protection of the first inventor, who needed only that his own claims should be valid; but

once the first application is treated as prior art when it fully anticipates, there seems to be no reason to deny it whatever effect it could have as prior art, if it were literally such. [Emphasis added.]

Petitioners, on the other hand, point to no case prior to 1952 where a copending patent was rejected as a reference on the ground which they now urge, namely, that it contained only a partial, rather than a complete, disclosure of the patent in issue. They do suggest that, prior to 1952, a number of cases "held that a copending patent is *not* embraced within the prior art as of its filing date but only as of the issue date." (Pet. Br., p. A-4). From this, petitioners reason that copending patents are not "prior art"—that is, are not valid references—in judging patentability under Section 103, which makes an invention nonpatentable "if the differences between the subject matter sought to be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *." [Emphasis added.]

While most of the cases cited by petitioner do contain general statements that copending patents are not "prior art," it is clear from a study of the complete opinions cited that these dicta represent merely a confusion of terminology in the use of the words "prior art" and not a recognition of rule limiting the use of copending patents as relevant references in judging the patentability of subsequent inventions. Indeed in all but one of the cases upon which peti-

tioners rely, the copending patents involved were, in fact, actually used to judge patentability despite the courts' statements that they were not part of the "prior art." The one exception is *In re Spencer*, 47 F. 2d 806 (C.C.P.A.) which does not contain the general statement that copending patents are not part of the prior art, and which, although it rejects a reference as relevant in judging patentability, apparently does so on the ground that the reference was filed after, rather than before, the patent in issue. See 47 F. 2d at 807. In all the remaining cases, one or more copending patents were used as relevant references. In some cases, *e.g.*, *United Specialties Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C.A. 6),* this was done without explicit recognition that use of a copending reference raised any issue of law.⁶ In other cases, the opinions contain express recognition that copending references are valid in judging patentability. In *Old Town Ribbon & Carbon Co. v. Columbia Ribbon & Carbon Mfg. Co.*, 159 F. 2d 379, 382 (C.A. 2), for example, Judge Learned Hand, after citing the *Milburn* case, states that "[a]ccordingly we are to treat the disclosure in Foster's [copending] specifications * * * precisely as though it had appeared in a printed publication before Lewis and Menihan [the patent in issue] had filed their application. The validity of the claims in suit therefore depends upon whether they can survive this disclosure * * *." Finally, five of the cases cited by petitioners

*Thus, in the *United Specialties* case, the copending Hinkle reference (186 F. 2d at 428) was used in a group along with other, clearly prior, references.

as stating that copending patents are not "prior art" under the doctrine of Section 103, are included in the citations, compiled above in footnote 5, wherein copending patents were used prior to 1952 although they contained only partial, rather than identical, disclosures of the patent in suit, thus directly rebutting petitioners' argument. (*United Specialities Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C.A. 6); *Permo, Inc. v. Hudson-Ross, Inc.*, 179 F. 2d 386 (C.A. 7); *Conmar Products Corporation v. Universal Slide Fastener Co.*, 172 F. 2d 150 (C.A. 2); *In re Walker*, 99 F. 2d 976 (C.C.P.A.); *In re Youker*, 77 F. 2d 624 (C.C.P.A.)).

Hence it is clear that statements in the opinions cited by petitioners, that copending patents are not "prior art," are not directed toward the use of copending patents as references relevant to patentability. Any such view would, indeed, be inconsistent with the uniform course of decisions in this and the lower courts. These statements merely reflect, we submit, the view that, as a matter of terminology, copending references are not *prior art* since they are not made public until after the patent in issue; they are, nevertheless *relevant art* since, under *Milburn*, they are constructively deemed issued on their application dates. "Prior art" was not a statutory term prior to 1952 (it appears only in Section 103, which was added in 1952) and this verbal confusion therefore was wholly irrelevant to the decision of the cases where it occurs. In any event, the verbal uncertainty was resolved by this Court's explicit decision in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, 265, that co-

pending patents were to be viewed as "prior art." See also, e.g., *Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F. 2d 345, 349 (C.A. 2), *supra*, pp. 16-18.

II

THE PATENT ACT OF 1952 DID NOT LIMIT THE USE OF COPENDING PATENTS AS REFERENCES RELEVANT TO PATENTABILITY

We have shown above that, prior to the Patent Act of 1952, it was clear beyond doubt that copending patents were relevant references, as of their filing dates, in determining the patentability of subsequent inventions whether or not competing inventors were involved in a contest for the same patent. This was true whether the copending prior reference disclosed the exact invention in the application in issue (as in *Alexander Milburn Co. v. Davis Bournonville Co.*, 270 U.S. 390) or whether it merely disclosed matter, in light of which the application in issue failed to disclose an advance beyond what would have been obvious to one skilled in the art (as in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259). Although some confusion existed as to whether the then non-statutory term, "prior art," was properly used in referring to such relevant copending patents (since such patents were not in the public domain prior to the subsequent invention), there was no doubt of their relevance and this Court, in the *Detrola* case, had indeed included copending patents within the label, "prior art."

We believe it clear, moreover, that no change was made by the 1952 Patent Act. Urging the contrary,

petitioners rely upon Section 103 of the 1952 Act, which, for the first time, expressly incorporated into the statute the rule of *Hotchkiss v. Greenwood*, 11 How. 248, under which changes within the ordinary skill of the art are not patentable. Section 103 reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Petitioners are mindful of the fact that, in addition to codifying the *Hotchkiss* rule for the first time in 1952, Congress also codified, in Section 102(e), the rule of *Alexander Milburn Co. v. Davis-Bournonville Co.*, *supra*, under which copending patents had uniformly been used as relevant references in cases falling under the *Hotchkiss* rule. As part of Section 102, subsection (e) is, indeed, one of a group of references made specifically relevant in judging patentability. Petitioners argue, despite the explicit incorporation of copending patents among these references, that Section 103 must be considered separately and that it looks only to "prior art" in determining whether an advance is patentable. "Prior art" in petitioners' view, cannot be deemed as a matter of language to refer to all the references listed in Sec-

tion 102, but only to those prior *public* references in Section 102(a), i.e., matter "known or used by others in the country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant ~~has~~ patent."

The short answer to petitioners' argument is that, in codifying *Milburn* and *Hotchkiss* in 1952, Congress showed no purpose, either within the statute or in the legislative history, to decrease the role of copending patents under those decisions; hence their previous use as relevant references was retained. That codification alone was intended is apparent: Thus the Reviser's Note to Section 102(e), codifying *Milburn*, states that "Paragraph (e) is new and enacts the rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor." The Reviser's Note to Section 103, codifying *Hotchkiss*, states that the section incorporates a rule as to "lack of invention or lack of patentable novelty" which "has been followed since at least as early as 1850." If, as petitioners argue, the 1952 Act—for the first time—meant to exclude the use of copending patents in Section 103 cases, the Reviser surely would have noted the change.

We conclude, therefore, that "prior art" in Section 103 means to refer—as this Court held in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259—to copending references as well as to all of the other references set forth in the subsections of Section 102. There is no basis for limiting the reference to subsection (a) of Sec-

tion 102 alone. Explicit confirmation of this conclusion that "prior art" refers generally to all of the references described in Section 102 is contained in the Committee Reports accompanying Section 103, where it is stated that the section "refers to the difference between the subject matter to be patented and the *prior art*, meaning what was known before *as described in section 102*" (emphasis added). H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess., p. 6 (1952). Indeed, P. J. Federico, Examiner-in-Chief of the Patent Office and an active participant in the 1952 revision, could not have made this clearer when he stated, with regard to this question, that "[t]he antecedent of the words 'the prior art' * * * lies in the phrase 'disclosed or described as set forth in Section 102' and hence these words refer to material specified in Section 102 as the basis for comparison." (Commentary on the New Patent Act, incorporated in Title 35, United States Code Annotated, at pp. 1, 20; emphasis added.) Hence "prior art," as that term is used in Section 103, refers to all of the references described in Section 102, including the copending references defined in subsection (e).⁷

⁷ An additional element in the legislative history supports the conclusion that "prior art" in Section 103 refers to all the references described in Section 102, including the copending references defined in subsection (e). The version of Section 103 originally introduced into the First Session of the Eighty-Second Congress (H.R. 3760) would have provided that (emphasis added):

A patent may not be obtained though the invention is not identically disclosed or described in the *prior art set forth in section 102* of this title, if the differences between the subject matter sought to be patented and *that prior art* are such that the subject matter as a whole would have been

The cases decided since the 1952 Act where the question has been fully considered uniformly adopt this construction. For example, in *Application of Harry*, 333 F. 2d 920, 923 n. 1, the Court of Customs and Patent Appeals said that "the legislative history of the 1952 Act makes it clear that 'copending patents' were intended to be part of the 'prior art' [within the meaning of Section 103]." See also *Application of Kander*, 312 F. 2d 834 (C.C.P.A.); *Application of Gregg*, 244 F. 2d 316, 319 (C.C.P.A.) and the decision

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

Had this version directly become law, it would have been clear beyond doubt from the face of the statute that the "prior art" by which advances in the art were to be judged under Section 103 was "the prior art set forth in section 102"—hence, that it included the copending art described in Section 102(e).

The changes made in Section 103 before enactment, however, indicate that the final version of the bill was meant to broaden even further—rather than to narrow—the "prior art" relevant under that section. These changes were made in response to a suggestion by the Bar Association of the City of New York that the language of the proposed Section 103 be changed so as "to make it clear that all prior art is here meant and not merely the prior art referred to in section 102 which is limited to anticipatory art." Senate Subcommittee on Patents, Trademarks and Copyrights, *Effects To Establish a Statutory Standard of Invention*, Study No. 7, 85th Cong., 1st Sess. p. 15. Specifically, the Association recommended that this be accomplished through the substitution of the word "as" for the phrase "in the prior art" in the original bill and by the substitution of the word "the" in place of the word "that" immediately following the conjunction "and" in the original. Hearings Before Subcommittee No. 3 of the House Committee on the Judiciary, 82d Cong., 1st Sess., p. 221 (1951). These changes were made and incorporated into the final bill as enacted. Thus "the prior art" in Section 103 indubitably means to include copending references as described in Section 102(e)

of the district court in this case (226 F. Supp. 459; R. 69, 73), with which the court of appeals, affirming *per curiam*, agreed.

Petitioners cite three cases allegedly to the contrary: *Weatherhead v. Drillmaster Supply Co.*, 227 F. 2d 98 (C.A. 7); *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148 (C.A. 2); and *John Blue Co. v. Dempster Mill Mfg. Co.*, 275 F. 2d 668 (C.A. 8) (see Petitioner's Brief at p. A-4 and pp. 15-20). The *John Blue* case reveals nothing in petitioner's favor beyond some continuing confusion regarding terminology; the copending patent there involved was, in fact, used as a relevant reference to judge patentability. Thus after noting that the Blue Patent, cited against the patent in issue, was copending, the court said: "It is true that the application for the Blue Patent cannot be considered as prior art in the technical sense, but it is a widely recognized rule that the application for such patent can nevertheless be used as defense material to prove that Blue and Johnson were not the original and first inventors or discoverers * * *" (275 F. 2d at 672). *Weatherhead*, it is true, does contain a statement that a copending patent "could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention" (227 F. 2d at 101) and similar language appears in *Helene Curtis* (see 233 F. 2d 156). These statements are dicta since, in both cases, the claims at issue were ultimately held unpatentable in the light of the prior art. In addition the *Weatherhead* case involved a situation of double patenting

by a single inventor, where special considerations apply which are inapplicable when different copending patentees are involved; and *Helene Curtis* contains the statement, seemingly in contradiction to the dictum relied upon by petitioners, that copending patents were "anticipatory under the doctrine of *Alexander Milburn Co. v. Davis-Bournonville Co.*, * * * now codified in 35 U.S.C.A. § 102(e)" because "a portion of each of these patents falls within the area of" the invention in issue (233 F. 2d at 158). Finally, neither of these decisions makes reference to this Court's decision in *Detrola Corp. v. Hazeltine Corp.*, *supra*, explicitly holding copending patents "prior art" for purposes of showing lack of patentable invention over the art; nor do they refer to the explicit legislative history to the same effect accompanying the 1952 Patent Act. To the extent that these dicta mean to indicate a preclusion of the use of copending patents as relevant art under Section 103, therefore, we submit that they are plainly erroneous.

Finally, petitioners argue that "[s]imple principles of equity and fair play" require that copending patents not be included in the art relevant under Section 103. (Pet. Br., pp. 23-25). Since such copending patents must "be kept in ^{confidence} accordance by the Patent Office" (35 U.S.C. 122) petitioners urge that a worker skilled in the art would not, in fact, be aware of them before his subsequent invention and, hence, that his invention should not be judged in their light.

It is true that under the rule applied to copending patents since the *Milburn* decision, inventors who may

have every reason to believe that they have arrived at a patentable invention may be denied patents because of information disclosed in copending patents of which they could not have known. The test of patentability, however, is not whether the applicant believes that he has made an invention in the subjective sense (see *Radio Corporation of America, et al. v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 11-14; *Sewall v. Jones*, 91 U.S. 171, 180; *Evans v. Eaton*, 3 Wheat. 454, 513-514; see also Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 21); it is whether the invention represents a significant advance over the art, objectively viewed. (See H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess., p. 6 (1952)). Thus, whether or not the inventor actually knew, or could have known, of the "prior art" material at the time he made his invention is irrelevant. The relevant question is whether his "invention," if patented, would constitute a significant contribution in light of other elements available to the public at the time his patent would issue, and a prior copending patent which is ultimately issued would be such a previously publicly available development.

This precise situation confronted the Court in *Milburn*. There, as here, a copending application, the existence of which the later applicant could not have known, disclosed the subject matter of the subsequent application. Notwithstanding the rule requiring the secrecy of patent applications, the Court held the teachings of the prior copending application relevant in testing the patentability of the later application.

Petitioners' suggestion (Pet. Br., p. 24) that "unfairness" in the *Milburn* case was overbalanced by the need to reward the prior of two rival inventors, is not borne out. In *Milburn*, the prior copending patentee did not claim the invention claimed in the subsequent application, and the two inventors were not rivals. It was this factor which led the district court and court of appeals, to hold the subsequent patent valid and it was the relevance of the presence of such a competing prior patentee which this Court explicitly rejected in reversing those decisions below. See pp. 11-13, *supra*.

Petitioners, on the other hand, ignore the unjustifiable burdens upon the public and the prior inventor that would potentially be caused by the issuance of two or more overlapping patents which, except for non-patentable variations, would cover the same subject matter. If both the Wallace and Regis patents were to issue, for example, a member of the public wishing to use the single patentable innovation embodied in both might have to obtain licenses from both patentees, and Wallace, the prior inventor, might have to obtain a license from Regis in order to make use of Regis' non-patentable variation. In addition, the Regis patent would improperly extend the monopoly on the basic invention vis-a-vis the general public beyond the statutory period previously awarded to Wallace. For these reasons, as well as those made explicit in the *Milburn* decision and the legislative history of the 1952 Act, the copending and ultimately issued Wallace patent was properly used to judge the patentability of Regis' application under Section 103 of the Patent Act.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

THURGOOD MARSHALL,
Solicitor General.

JOHN W. DOUGLAS,
Assistant Attorney General.

PAUL BENDER,
Assistant to the Solicitor General.

LAWRENCE R. SCHNEIDER,
Attorney.

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